

PATENT  
1247-0464P

**IN THE U.S. PATENT AND TRADEMARK OFFICE**

IN RE APPLICATION OF

BEFORE THE BOARD OF APPEALS

Akitoshi KOJIMA et al.

Appeal No.:

APPL. NO.: 09/995,652

GROUP: 3689

FILED: November 29, 2001

EXAMINER: G. ARAQUE

FOR: METHOD AND SYSTEM FOR MERCHANDISE RETAIL  
MANAGEMENT AND PORTABLE TERMINAL

**APPEAL BRIEF**

IN RE APPLICATION OF

BEFORE THE BOARD OF APPEALS

Akitoshi KOJIMA et al.

Appeal No.:

APPL. NO.: 09/995,652

GROUP: 3689

FILED: November 29, 2001

EXAMINER: G. ARAQUE

FOR: METHOD AND SYSTEM FOR MERCHANDISE RETAIL  
MANAGEMENT AND PORTABLE TERMINAL

### **TABLE OF CONTENTS**

APPEAL BRIEF ON BEHALF OF APPELLANT: Akitoshi KOJIMA et al.	1
I. REAL PARTY IN INTEREST .....	2
II. RELATED APPEALS AND INTERFERENCES.....	2
III. STATUS OF CLAIMS .....	2
IV. STATUS OF AMENDMENTS .....	2
V. SUMMARY OF THE INVENTION .....	2
VI. THE GROUNDS OF REJECTION .....	4
VII. ARGUMENT .....	6
VIII. CONCLUSION.....	20
Appendix of Claims.....	A-1
Appendix B.....	B-1
Appendix C.....	C-1

IN RE APPLICATION OF

BEFORE THE BOARD OF APPEALS

Akitoshi KOJIMA et al.

Appeal No.:

APPL. NO.: 09/995,652

GROUP: 3689

FILED: November 29, 2001

EXAMINER: G. ARAQUE

FOR: METHOD AND SYSTEM FOR MERCHANDISE RETAIL  
MANAGEMENT AND PORTABLE TERMINAL

**APPEAL BRIEF ON BEHALF  
OF APPELLANTS:  
AKITOSHI KOJIMA et al.**

**MS APPEAL BRIEF**

Board of Patent Appeals and Interferences  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This appeal is from the decision of the Examiner dated June 10, 2008, rejecting claims 1-16, which are reproduced as an Appendix to this Brief. Appellants hereby submit the following Appeal Brief in support of the Notice of Appeal filed October 9, 2008.

The Commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17, and 1.21 that may be required by this paper and to credit any overpayment to Deposit Account No. 02-2448.

**I. REAL PARTY IN INTEREST**

The real parties in interest are the assignees of the entire interest in the above-captioned patent application, Kojima Co., Ltd. and SHARP KABUSHIKI KAISHA, 1-8, Hoshigaoka 2-chome, Utsunomiya-shi, Tochigi, JAPAN and 22-22, Nagaike-cho, Abeno-ku, Osaka, JAPAN, respectively.

**II. RELATED APPEALS AND INTERFERENCES**

There are no related appeals or interferences that will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

**III. STATUS OF CLAIMS**

Claims 1-16 remain pending. Claims 1, 3, and 14 are independent. No claims have been allowed.

**IV. STATUS OF AMENDMENTS**

No amendments have been presented after the Final Rejection.

**V. SUMMARY OF THE INVENTION**

The invention of claim 1 is directed to a merchandise retail management method comprising the steps of putting a tag on display together with a sample commodity in a display area, commodity information including an identification code of the commodity, being allowed to be read from and written to the tag [Specification, paragraph 0022 and 0109]; lending out a portable terminal capable of reading the tag to a customer entering the display area [Specification, paragraph 0094]; reading the commodity information from the tag, which is put on display together with the corresponding sample commodity, with the portable terminal when the customer indicates an interest in purchasing the commodity [Specification, paragraph 0095]; storing the corresponding commodity information in the portable terminal and relaying it to an

information-processing apparatus for merchandise management and sales management [Specification, paragraph 0095]; comparing at the information-processing apparatus the commodity information which has already been relayed to the information-processing apparatus, with commodity information which is sent from the portable terminal to a POS apparatus at a sales counter and is then entered into the information-processing apparatus; the customer returning the portable terminal when leaving; and handing over the commodity to the customer after the commodity to be sold has been prepared in accordance with the comparison result of commodity information at the information-processing apparatus [Specification, paragraph 0097].

The invention of claim 3 is directed to a merchandise retail management system for aggregating commodity information of commodities that a customer indicates an intent to purchase from among sample commodities which are on display in a display room, and for preparing the commodities, comprising a wireless tag displayed on each sample commodity, wherein commodity information, including an identification code of that commodity can be read from and written to the wireless tag via radio waves [Specification, paragraph 0022]; a portable terminal that is held by customers that have entered the display room, and which is capable of reading the commodity information on the wireless tag, that stores commodity information that has been read out and relays the commodity information to the outside [Specification, paragraph 0094]; a POS apparatus adapted to receive the commodity information sent from the portable terminal at a sales counter [Specification, paragraph 0096]; and an information-processing apparatus for receiving the relay from the portable terminal, indicating what commodity to have prepared in accordance to what the customer has indicated the intent to purchase and comparing the commodity information which has already been relayed to the information-processing apparatus,

with commodity information which is sent from the portable terminal to the POS apparatus and is then entered into the information-processing apparatus [Specification, paragraph 0097].

The invention of claim 14 is directed to a portable terminal comprising a tag reader for reading via radio waves commodity information written onto a wireless tag located on a sample commodity remote from a checkout area and customer identifying information written onto another wireless tag [Specification, paragraph 0022]; a storage for accumulating and storing commodity information that has been read by the tag reader [Specification, paragraph 0095]; a wireless communication device for transmitting commodity information to an information-processing apparatus via radio waves at the same time that the commodity information is stored in the storage [Specification, paragraph 0095], and transmitting the customer identifying information to the information-processing apparatus via radio waves [Specification, paragraph 0109]; and a display for displaying the commodity information that has been read out [Specification, paragraph 0110].

The summary of the claimed invention herein is made to comply with the Patent Office rules in submitting briefs and is not to be considered as limiting the claimed invention. Further, the references to the specification herein are exemplary, and additional support for these claim elements may be found in different portions of the specification.

## **VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

The Final Office Action provides three (3) grounds of rejection for review on appeal.

- (1) Claim 14 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Trotta Jr. (USP 5,595,264) (hereinafter “Trotta”);

- (2) Claims 1-13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Trotta in view of Garver (USP 7,114,656) (hereinafter “Garver”); and
- (3) Claims 15-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Trotta in view of Garver and further in view of Murrah et al. (USP 5,804,807) (hereinafter “Murrah”).

## **VII. ARGUMENTS**

### **A. The Rejection of Claim 14 Under 35 U.S.C. § 102(b) as Being Anticipated by Trotta Fails to Establish *Prima facie* Anticipation**

#### **1. Argument Summary**

The Examiner's rejection of claim 14 under 35 U.S.C. § 102(b) as being anticipated by Trotta fails to establish *prima facie* anticipation. Generally, the deficiencies of the rejection are that the rejection attributes certain claimed features to the Trotta reference that a detailed reading of the reference reveals are not taught therein.

#### **2. The Legal Requirements of *Prima Facie* Anticipation**

In order to properly anticipate Appellants' claimed invention under 35 U.S.C. §102(b), each and every element of the claim in issue must be found, either expressly described or under principles of inherency, in a single prior art reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. §2131 (8th Ed., Aug. 2001), quoting Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Finally, "[t]he elements must be arranged as required by the claim." M.P.E.P. §2131 (8th ed. 2001), p. 2100-69.

#### **3. Trotta fails to teach or suggest "a tag reader for reading via radio waves commodity information written onto a wireless tag located on a same commodity remote from the checkout area and customer identifying information written onto another wireless tag," as required by claim 14.**

Independent claim 14 is directed to a portable terminal comprising a tag reader for reading via radio waves commodity information written onto a wireless tag located on a sample commodity remote from a checkout area and customer identifying information written onto another wireless tag; a storage for accumulating and storing commodity information that has



been read by the tag reader; a wireless communication device for transmitting commodity information to an information-processing apparatus via radio waves at the same time that the commodity information is stored in the storage, and transmitting the customer identifying information to the information-processing apparatus via radio waves; and a display for displaying the commodity information that has been read out.

In support of the Examiner's rejection of claim 14, the Examiner asserts on page 2, paragraph 4, of the final Official Action as follows:

In regards to claim 14, Trotta discloses a portable terminal comprising:  
tag reader for reading via radio waves commodity information written onto a wireless tag located on a sample commodity remote from a checkout area and customer identifying information written onto another wireless tag(Fig. 4 #23); ...  
wireless communication device for transmitting commodity information to an information-processing apparatus via radio waves at the same time that he commodity information is stored in the storage and transmitting the customer identifying information to the information-processing apparatus via radio waves (Fig. 4 #40)...

Appellants respectfully disagree that the teachings of Trotta are sufficient to anticipate at least these claim elements.

The disclosure of Trotta is directed to a system and method for automated shopping. At col. 6, lines 20-32, Trotta discloses as follows:

In a further preferred embodiment of the invention, the payment card 10 is used for identification of the customer during his shopping and the total purchase price of the items is deducted from the customer's account at completion of the shopping. As the selected items are scanned, the in-store computer 20 merely records the purchase to the customer's account and the receipt. Then, once the customer has finished shopping and returned the scanner 14 to its holder 16, the display panel 22 will ask the customer to confirm the final purchase total by pressing the green button 24. Once actuated, the computer 20 debits the total purchase to the customer's payment card 10, and a receipt is issued to the customer.

As can be seen from the above disclosure, Trotta discloses that a payment card 10 is used for identification of a customer, the payment card 10 being inserted into a slot 12 of a scanner

terminal 18. In the disclosure of Trotta, customer identifying information of the payment card 10 is neither read from a wireless tag using a portable scanner 14 via radio waves, nor transmitted to an information processing apparatus via radio waves.

As Trotta fails to teach or suggest all of the claim elements, Appellants respectfully submit that claim 14 is not anticipated by, and thus allowable over, the teachings of Trotta.

**a. The claim elements are not directed to “intended use” as asserted by the Examiner.**

In their previous reply, Appellants argued that Trotta fails to anticipate claim 14 as Trotta fails to teach or suggest customer identifying information written onto another wireless tag. In response to this argument, the Examiner asserted that he is not affording patentable weight to the type of information stored on the wireless tag. He asserts that this claim element is a recitation of intended use and that the structure of the claim is the same as the structure recited in Trotta. The Examiner concludes that since the structure is Trotta is capable of performing the intended use, then the teachings are sufficient to teach the claim element. Appellants respectfully disagree with the Examiner’s interpretation of “intended use.”

The Examiner’s form paragraph used in response to Appellants’ arguments is found under the heading “Answering Asserted Advantages” in the MPEP. In contrast, the arguments presented in our previous reply recite elements that are explicitly recited in the claims and are not asserted advantages as a result of the claimed invention. As such, the Examiner is clearly misinterpreting the rules for claim interpretation.

It is well established that the Examiner must afford patentable weight to all of the elements recited in claim. Appellants submit that the Examiner’s failure to afford proper

patentable weight to the functionality of the tag reader, as clearly recited in the body of the claim is wholly improper.

**b. The claim elements are not directed to “non-functional descriptive material” as asserted by the Examiner.**

The Examiner further asserts that customer identifying information amounts to non-functional descriptive material. However, the claims, when read in light of the specification, provide for customer identifying information read from a wireless tag. The information that is read from the tag is then transmitted together with the commodity information to an information-processing apparatus. Appellants submit that the customer identifying information is not merely non-functional descriptive material.

For at least these reasons, Appellants respectfully submit that claim 14 is not anticipated by Trotta.

**B. The Rejection of Claims 1-13 Under 35 U.S.C. § 103(a) as Being Unpatentable over Trotta in view of Garver Fails to Establish *Prima facie* Obviousness**

**1. Argument Summary**

The reasoning provided in support of the rejection of claims 1-13 under 35 U.S.C. § 103(a) as being unpatentable over Trotta in view of Garver fails to establish *prima facie* obviousness. Generally, the deficiencies of the rejection are that the rejection attributes certain claimed features to the references that a detailed reading of the references reveals are not taught therein. Such deficiencies exist for the rejection of each of claims 1-13.

## **2. Legal Requirements of *Prima facie* Obviousness**

To establish *prima facie* obviousness, all claim limitations must be taught or suggested by the prior art and the asserted modification or combination of the prior art must be supported by some teaching, suggestion, or motivation in the applied references or in knowledge generally available to one skilled in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The prior art must suggest the desirability of the modification in order to establish a *prima facie* case of obviousness. *In re Brouwer*, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1995). It can also be said that the prior art must collectively suggest or point to the claimed invention to support a finding of obviousness. *In re Hedges*, 783 F.2d 1038, 1041, 228 USPQ 685, 687 (Fed. Cir. 1986); *In re Ehrreich*, 590 F.2d 902, 908-909, 200 USPQ 504, 510 (C.C.P.A. 1979).

The teaching or suggestion to make the asserted combination or modification of the primary reference must be found in the prior art and cannot be gleaned from applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). In other words, the use of hindsight to reconstruct the claimed invention is impermissible. *Uniroyal Inc. v. Rudlan-Wiley Corp.*, 5 USPQ 1434 (Fed. Cir. 1983).

Finally, when considering the differences between the primary reference and the claimed invention, the question for assessing obviousness is not whether the differences themselves would be been obvious, but instead whether the claimed invention as a whole would have been obvious. *Stratoflex Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983).

## **3. The Rejection Fails to Establish *Prima facie* Obviousness of Independent Claim 1**

Independent claim 1 is directed to a merchandise retail management method comprising the steps of putting a tag on display together with a sample commodity in a display area,

commodity information including an identification code of the commodity, being allowed to be read from and written to the tag; lending out a portable terminal capable of reading the tag to a customer entering the display area; reading the commodity information from the tag, which is put on display together with the corresponding sample commodity, with the portable terminal when the customer indicates an interest in purchasing the commodity; storing the corresponding commodity information in the portable terminal and relaying it to an information-processing apparatus for merchandise management and sales management; comparing at the information-processing apparatus the commodity information which has already been relayed to the information-processing apparatus, with commodity information which is sent from the portable terminal to a POS apparatus at a sales counter and is then entered into the information-processing apparatus; the customer returning the portable terminal when leaving; and handing over the commodity to the customer after the commodity to be sold has been prepared in accordance with the comparison result of commodity information at the information-processing apparatus.

In maintaining the rejection of independent claim 1 based on Trotta and Garver, the Examiner asserts in the Final Office Action on page 4, para. 7, as follows:

...comparing at the information-processing apparatus the commodity information which has already been relayed to the information-processing apparatus, with commodity information which is sent from the portable terminal to a POS apparatus at a sales counter and is then entered into the information-processing apparatus (col. 4 Lines 30-40; see also at least col. 6 Lines 2-8; wherein the information processing apparatus is the in-store computer that keeps the running total of the customer's purchase [Col. 5 Lines 35-42] and receives the information as the customer is scanning the commodity and wherein the scanner terminal acts as the POS apparatus since it is the location where payment is finalized. Further still, a comparison must be made since the file that is stored at the in-store computer must contain some type of identifier, which would identify the scanner with the customer, and when the scanner is placed back at the scanner terminal another type of identifier must then be transmitted from the scanner terminal to the in-store computer in order to compare that the two identifiers are the same in order to release the customer's payment card and the printing of the receipt of the total purchases.);...

Appellants disagree with the Examiner's characterization of the cited references.

As can be seen from the Examiner's rejection, the Examiner relies on the in-store computer to teach the claimed information processing apparatus. The Examiner further relies on the scanner terminal to teach the claimed POS apparatus.

Claim 1 clearly requires comparing at the information-processing apparatus the commodity information which has already been relayed to the information-processing apparatus, with commodity information which is sent from the portable terminal to a POS apparatus at a sales counter and is then entered into the information-processing apparatus.

In contrast, the disclosure of Trotta is directed to a system and method for automated shopping. A system and method of automated shopping, including a portable bar code scanner for scanning bar code indicia information on items selected to be purchased, securing the scanner in a holder for limited access, and releasing the portable bar code scanner upon receiving an authorized payment card. A plurality of items for purchase are displayed in a store such that a customer can select an item to be purchased from the store display. The customer scans the bar code indicia on the selected item from the store display. The payment card is debited for the purchase price of the selected item and then returned to the customer. (Abstract).

Trotta discloses at col. 4, lines 30-40 as follows:

Portable scanner 14 includes an optical scanner 23 which transmits the encoded bar code indicia information to a microprocessor 25, as diagrammatically shown in FIG. 4. Keypad buttons 24, 26, 28 also communicate the customer's selection to the microprocessor 25. Microprocessor 25 then transmits this received information to the in-store computer 20 by way of a transceiver 40 and transaction encoder/decoder 42. Computer 20 processes this information and returns the appropriate signal to microprocessor 25 such that the customer is correctly informed of their shopping purchase.

Trotta, at col. 3, lines 8-11, discloses as follows:

Thus, when the selected items are scanned, the in-store computer merely records the purchase to the customer's account and the receipt. Then, once the customer has finished shopping and returned the scanner to its holder, the customer pushes a button on

the scanner to confirm the final purchase of the scanned items and the computer debits the total purchase to the customer's payment card.

At col. 5, lines 30-40, Trotta discloses as follows:

Meanwhile, when the green button is depressed to confirm the purchase of the scanned item the transaction is then encoded according to well-known manner, the scanner 14 transmits the purchase information to a central, in-store computer 20 using one of the above-mentioned wireless technologies. The in-store computer 20 performs several functions including (1) keeping a running total of the customer's purchases, (2) relaying the item selected for purchase to an inventory retrieval system 38, (3) adjusting the store's warehouse inventory to reflect the purchase of the item, and in one preferred embodiment, (4) debiting the customer's payment card 10 for the purchase price of the selected item.

At col. 6, lines 2-8, Trotta discloses as follows:

Therefore, the customer returns to the scanner terminal 18 and replaces the scanner 14 in the holder 16 from which he originally removed it. Thereafter, the customer's payment card 10 is released for return to the customer and a receipt of the total purchases is printed for the customer and, preferably, includes the box or bag number identified for the customer.

Finally, Trotta discloses in col. 6, lines 19-32, as follows:

In a further preferred embodiment of the invention, the payment card 10 is used for identification of the customer during his shopping and the total purchase price of the items is deducted from the customer's account at completion of the shopping. As the selected items are scanned, the in-store computer 20 merely records the purchase to the customer's account and the receipt. Then, once the customer has finished shopping and returned the scanner 14 to its holder 16, the display panel 22 will ask the customer to confirm the final purchase total by pressing the green button 24. Once actuated, the computer 20 debits the total purchase to the customer's payment card 10, and a receipt is issued to the customer.

However, there is no teaching or suggestion in Trotta that is directed to commodity information which is sent **from the portable terminal** to a **POS apparatus** at as sales counter. Trotta at most discloses the scanner transmitting the encoded bar code indicia to the in-store computer. However, there is no teaching in Trotta that is directed to commodity information that is sent from the portable terminal to a POS apparatus.

In addition, there is no disclosure that is directed to comparing, at the information processing apparatus, the commodity information which has already been relayed to the information processing apparatus, with commodity information which is sent from the portable terminal to a POS apparatus at a sales counter and is then entered into the information processing apparatus.

Trotta clearly discloses the in-store computer receiving the transmission of the bar code indicia from the scanner, keeping a running total of the customer's purchases, and debiting the customer's payment card (see col. 5, lines 34-42). There is no teaching in Trotta that is directed to the scanner sending commodity information to a POS apparatus as noted above. Further, there is no teaching or suggestion that is directed to comparing, at the information processing apparatus, the commodity information which has already been relayed to the information processing apparatus, with commodity information which is sent from the portable terminal to a POS apparatus at a sales counter and is then entered into the information processing apparatus.

In their previous reply, Appellants argued that the cited references fail to teach or suggest "comparing at the information-processing apparatus the commodity information which has already been relayed to the information-processing apparatus, with commodity information **which is sent from the portable terminal to a POS apparatus at a sales counter** and is then entered into the information-processing apparatus."

In response to this argument, the Examiner asserts in the final Official Action on page 11-12 as follows:

.. a comparison must be made since the file that is stored at the in-store computer must contain some type of identifier, which would identify the scanner with the customer, and when the scanner is placed back at the scanner terminal, another type of identifier must be transmitted from the scanner terminal to the in-store computer in order to compare that



the two identifiers are the same in order to release the customer's payment card and the printing of the receipt of the total purchases.”

However, the court in *In re Robertson* held “to establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

The Examiner asserts that it is inherent that the system compares at the information-processing apparatus the commodity information which has already been relayed to the information-processing apparatus, with commodity information which is sent from the portable terminal to a POS apparatus at a sales counter and is then entered into the information-processing apparatus. This assertion is supported by his statement that the system must compare **identifier information** in order to confirm the transaction. However, it appears that the Examiner is misinterpreting the claim language.

Claim 1 clearly requires that the system **compares** at the information-processing apparatus **the commodity information** which has already been relayed to the information-processing apparatus, **with commodity information** which is sent from the portable terminal to a POS apparatus at a sales counter and is then entered into the information-processing apparatus. By the Examiner's own statement, in considering the cited art, it is possible to perform the transaction in a different manner, namely by comparing **identifier information** that identifies the scanner used by the customer, and not commodity information as required by the claim. Thus, since it does not necessarily flow that the system compares at the information-processing apparatus the commodity information which has already been relayed to the information-

processing apparatus, with commodity information which is sent from the portable terminal to a POS apparatus at a sales counter and this then entered into the information-processing apparatus, Appellants maintain that it is not inherent that the system must compare the commodity information as required by the claim.

For the reasons set forth above, Appellants maintain that Trotta fails to teach or suggest “comparing at the information-processing apparatus the commodity information which has already been relayed to the information-processing apparatus, with commodity information **which is sent from the portable terminal to a POS apparatus at a sales counter** and is then entered into the information-processing apparatus,” as suggested by the Examiner.

Appellants respectfully submit that Garver fails to cure the deficiencies of the teachings of Trotta by failing to teach or suggest this claim element.

As neither Trotta nor Garver teach or suggest all of the claim elements, Appellants respectfully submit that claim 1 is not obvious over the teachings of the cited references. It is respectfully requested that the outstanding rejection be withdrawn.

#### **4. The Rejection Fails to Establish *Prima facie* Obviousness of Dependent Claim 2**

Claim 2 depends directly on claim 1. Appellants submit that the rejection under 35 U.S.C. § 103(a) based on Trotta in view of Garver fails to establish *prima facie* obviousness for dependent claim 2 at least for the reasons set forth above with regard to claim 1. Appellants further submit that dependent claim 2 is separately patentable and offer the following additional argument for the invention of claim 2.

The rejection of claim 2 appears to assert that Trotta teaches the incremental features as recited therein. Appellants respectfully submit, however, that the rejection’s reliance on Trotta as

allegedly teaching this claim feature fails to make up for the deficiencies of the rejection as applied to claim 1. Thus, Trotta, taken alone or in combination with Garver, assuming these references are combinable, which Appellants do not admit, fails to establish *prima facie* obviousness of dependent claim 2.

**5. The Rejection Fails to Establish *Prima facie* Obviousness of Independent Claim 3**

Independent claim 3 is directed to a merchandise retail management system for aggregating commodity information of commodities that a customer indicates an intent to purchase from among sample commodities which are on display in a display room, and for preparing the commodities, comprising a wireless tag displayed on each sample commodity, wherein commodity information, including an identification code of that commodity can be read from and written to the wireless tag via radio waves; a portable terminal that is held by customers that have entered the display room, and which is capable of reading the commodity information on the wireless tag, that stores commodity information that has been read out and relays the commodity information to the outside; a POS apparatus adapted to receive the commodity information sent from the portable terminal at a sales counter; and an information-processing apparatus for receiving the relay from the portable terminal, indicating what commodity to have prepared in accordance to what the customer has indicated the intent to purchase and comparing the commodity information which has already been relayed to the information-processing apparatus, with commodity information which is sent from the portable terminal to the POS apparatus and is then entered into the information-processing apparatus.

The Examiner's relies on the teachings noted above to support his rejection of claim 3.

**a. The Examiner Has Failed to Properly Consider All of the Claim Elements**

In support of his rejection of claim 3, the Examiner merely refers to the elements recited in claim 1. However, claim 3 clearly requires a POS apparatus adapted to receive the commodity information sent from the portable terminal at a sales counter. Claim 3 further requires an information-processing apparatus for receiving the relay from the portable terminal, indicating what commodity to have prepared in accordance to what the customer has indicated the intent to purchase and comparing the commodity information which has already been relayed to the information-processing apparatus, with commodity information which is sent from the portable terminal to the POS apparatus and is then entered into the information-processing apparatus. The Examiner failed to refer to these claim elements in his rejection of this claim. At least for this reason, the outstanding rejection is improper.

**b. The Cited References Fail to Teach or Suggest “a POS apparatus adapted to receive the commodity information sent from the portable terminal at a sales counter.”**

The teachings of Trotta are noted above. As can be seen from the teachings of Trotta, Trotta merely discloses transmitting the bar code indica from the scanner to the in-store computer. There is no disclosure that is directed to the scanner terminal receiving commodity information from the scanner.

As such, Appellants maintain the Examiner has failed to provide references that teach or suggest this claim element.

In addition, claim 3 clearly recites an information-processing apparatus for comparing the commodity information which has already been relayed to the information-processing apparatus, with commodity information which is sent from the portable terminal to the POS apparatus and is

then entered into the information-processing apparatus. As noted above with regard to claim 1, there is no teaching or suggestion in Trotta that is directed to comparing the commodity information which has already been relayed to the information-processing apparatus, with commodity information which is sent from the portable terminal to the POS apparatus and is then entered into the information-processing apparatus.

Garver fails to cure the deficiencies of the teachings of Trotta as Garver fails to teach or suggest these claim elements.

As neither of the cited references, either alone or in combination, teach or suggest all of the claim elements, Appellants maintain that the Examiner has failed to establish *prima facie* obviousness under 35 U.S.C. § 103. Appellants maintain that claim 13 is patentable over the references as cited.

**6. The Rejection Fails to Establish *Prima facie* Obviousness of Dependent Claims 4-13 and 16**

Claims 4-13 and 16 depend directly or indirectly on claim 3. Appellants submit that the rejection under 35 U.S.C. § 103(a) based on Trotta in view of Garver fails to establish *prima facie* obviousness for dependent claims 4-13 and 16 at least for the reasons set forth above with regard to claim 3. Appellants further submit that dependent claims 4-13 and 16 are separately patentable and offer the following additional argument for the invention of claims 4-13 and 16.

The rejection of claims 4-13 and 16 appears to assert that Trotta teaches the incremental features as recited therein. Appellants respectfully submit, however, that the Examiner's reliance on Trotta as allegedly teaching these claim features fails to make up for the deficiencies of the rejection as applied to claim 3. Thus, Trotta, taken alone or in combination with Garver, assuming these references are combinable, which Appellants do not admit, fails to establish *prima facie* obviousness of dependent claims 4-13 and 16.

**7. The Rejection Fails to Establish *Prima facie* Obviousness of Dependent Claim 15.**

Claim 15 depends directly or indirectly on claim 1. Appellants submit that the rejection under 35 U.S.C. § 103(a) based on Trotta in view of Garver fails to establish *prima facie* obviousness for dependent claim 15 at least for the reasons set forth above with regard to claim 1. Appellants further submit that dependent claim 15 is separately patentable and offer the following additional argument for the invention of claim 15.

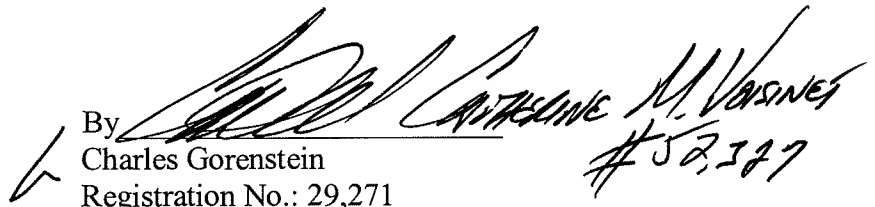
The rejection of claim 15 appears to assert that Trotta teaches the incremental features as recited therein. Appellants respectfully submit, however, that the Examiner's reliance on Trotta as allegedly teaching these claim features fails to make up for the deficiencies of the rejection as applied to claim 1. Thus, Trotta, taken alone or in combination with Garver, assuming these references are combinable, which Appellants do not admit, fails to establish *prima facie* obviousness of dependent claim 15.

**VIII. CONCLUSION**

The withdrawal of the outstanding rejections and the allowance of claims 1-16 is earnestly solicited.

Dated: December 8, 2008

Respectfully submitted,

By  *CHARLES M. GORENSTEIN*  
Charles Gorenstein  
Registration No.: 29,271  
BIRCH, STEWART, KOLASCH & BIRCH, LLP  
8110 Gatehouse Road  
Suite 100 East  
P.O. Box 747  
Falls Church, Virginia 22040-0747  
(703) 205-8000  
Attorney for Appellants

### **Appendix of Claims**

1. (Previously presented) A merchandise retail management method comprising the steps of:

putting a tag on display together with a sample commodity in a display area, commodity information including an identification code of the commodity, being allowed to be read from and written to the tag;

lending out a portable terminal capable of reading the tag to a customer entering the display area;

reading the commodity information from the tag, which is put on display together with the corresponding sample commodity, with the portable terminal when the customer indicates an interest in purchasing the commodity;

storing the corresponding commodity information in the portable terminal and relaying it to an information-processing apparatus for merchandise management and sales management;

comparing at the information-processing apparatus the commodity information which has already been relayed to the information-processing apparatus, with commodity information which is sent from the portable terminal to a POS apparatus at a sales counter and is then entered into the information-processing apparatus;

the customer returning the portable terminal when leaving; and

handing over the commodity to the customer after the commodity to be sold has been prepared in accordance with the comparison result of commodity information at the information-processing apparatus.

2. (Original) The merchandise retail management method of claim 1, wherein a wireless tag is used which commodity information is allowed to be read from and written to via radio

waves, and the commodity information is relayed to the information-processing apparatus at the same time when the commodity information is read from the wireless tag.

3. (Previously presented) A merchandise retail management system for aggregating commodity information of commodities that a customer indicates an intent to purchase from among sample commodities which are on display in a display room, and for preparing the commodities, comprising:

a wireless tag displayed on each sample commodity, wherein commodity information, including an identification code of that commodity can be read from and written to the wireless tag via radio waves;

a portable terminal that is held by customers that have entered the display room, and which is capable of reading the commodity information on the wireless tag, that stores commodity information that has been read out and relays the commodity information to the outside;

a POS apparatus adapted to receive the commodity information sent from the portable terminal at a sales counter; and

an information-processing apparatus for receiving the relay from the portable terminal, indicating what commodity to have prepared in accordance to what the customer has indicated the intent to purchase and comparing the commodity information which has already been relayed to the information-processing apparatus, with commodity information which is sent from the portable terminal to the POS apparatus and is then entered into the information-processing apparatus.

4. (Original) The merchandise retail management system of claim 3, further comprising a rewriting apparatus for rewriting the commodity information on the wireless tag.



5. (Original) The merchandise retail management system of claim 3, wherein the portable terminal includes:

input means with which the customer commands an arithmetic process relating to stored commodity information; and

arithmetic means for conducting arithmetic processing according to the command to the input means.

6. (Original) The merchandise retail management system of claim 4, wherein the portable terminal includes:

input means with which the customer commands an arithmetic process relating to stored commodity information; and

arithmetic means for conducting arithmetic processing according to the command to the input means.

7. (Previously presented) The merchandise retail management system of claim 3, wherein the portable terminal includes:

input means with which the customer designates stored commodity information; and

display means for displaying commodity information in accordance with the designation made to the input means.

8. (Previously presented) The merchandise retail management system of claim 3, wherein the portable terminal relays commodity information to at least one of a POS apparatus and an information processing apparatus at the same time that the portable terminal reads out the commodity information from the wireless tag.

9. (Original) The merchandise retail management system of claim 3, wherein the information-processing apparatus includes:

wireless communication means for wireless communication with the portable terminal held by a customer checking out; and

customer specification means for specifying customers by wireless communication via the wireless communication means.

10. (Original) The merchandise retail management system of claim 9, wherein the information-processing apparatus further includes:

commodity information readout means for reading out the commodity information stored in the portable terminal through wireless communication with the portable terminal via the wireless communication means;

display means for displaying a list of commodity information that has been read out by the commodity information readout means;

correction input means for receiving corrected input from customers who have viewed the list displayed by the display means; and

commodity correction means for correcting commodity information in accordance with the corrected input when the corrected input means receives corrected input.

11. (Original) The merchandise retail management system of claim 10, wherein the information-processing apparatus carries out revision and addition of information to the list

through wireless communication with the portable terminal via the wireless communication means.

12. (Original) The merchandise retail management system of claim 10, wherein the information-processing apparatus is further provided with payment processing means capable of processing payment for sales, displayed by the display means.

13. (Original) The merchandise retail management system of claim 11, wherein the information-processing apparatus is further provided with payment processing means capable of processing payment for sales, displayed by the display means.

14. (Previously presented) A portable terminal comprising:

a tag reader for reading via radio waves commodity information written onto a wireless tag located on a sample commodity remote from a checkout area and customer identifying information written onto another wireless tag;

a storage for accumulating and storing commodity information that has been read by the tag reader;

a wireless communication device for transmitting commodity information to an information-processing apparatus via radio waves at the same time that the commodity information is stored in the storage, and transmitting the customer identifying information to the information-processing apparatus via radio waves; and

a display for displaying the commodity information that has been read out.

15. (Previously presented) The merchandise retail management method of claim 1, wherein the portable terminal reads via radio waves customer identifying information written

onto another wireless tag, and transmits the customer identifying information to the information-processing apparatus via radio waves.

16. (Previously presented) The merchandise retail management system of claims 3, wherein the portable terminal reads via radio waves customer identifying information written onto another wireless tag, and transmits the customer identifying information to the information-processing apparatus via radio waves.

## APPENDIX B

There is no additional evidence pursuant to §§ 1.130, 1.131, or 1.132 and/or evidence entered by or relied upon by the examiner that is relevant to this appeal.

## APPENDIX C

There are no related proceedings.